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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,092	09/05/2003	Peter Albany	2024738/7034342001	9925

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EXAMINER

LEE, SEUNG H

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,092

Applicant(s)

ALBANY, PETER

Examiner

Seung H. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/11/03, 04/11/05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 5, 8, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Abrams (WO 02/21425 A2, cited by applicant).

Abrams teaches a disposable specimen container such as a vial for obtaining the patient urine or blood specimen and the read/write data storage device such as a RFID device is attached to the specimen vial wherein the blood specimen also serves as a cytological specimen, the RDIF also storing individual of identification (see page 2, lines 14-26; page 4, lines 2-16).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abrams in view of Weissman (US 5,561,556)

The teachings of Abrams have been discussed above.

Although, Abrams teaches the specimen container having the storage device such as the RFID device attached to the container, he fails to particularly teach or fairly suggest that the specimen is a slide and the data storage device is a magnetic or optical storage device.

However, Weissman teaches a microscope slide (1) for containing specimen (2) wherein the slide comprises a magnetic stripe (6a) or optically read/writable stripe (6b) (see figs. 1a and 1b; col. 4, lines 7-51; col. 5, line 56- col. 6, line 39)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Weissman to the teachings of Abrams in order to provide an alternative device to store data regarding specimen into the magnetic stripe or optical stripe instead of the RFID device wherein the history of screening of pathology analysis of specimen is generated by the computer using data in the magnetic or optical stripe of the slide. Moreover, such modification (e.g., using the magnetic or optical stripe to store data instead of the RFID device) would reduce cost of operating of analyzing of specimen due to the cheaper price of the storage medium (e.g., a magnetic or optical stripe) and reader/writer capable of writing/reading data to/from the magnetic or optical stripe compare to that of the RFID device.

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5. Claims 9-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abrams as modified by Weissman, and further in view of Ellis et al. (US 6,631,203)(hereinafter referred to as 'Ellis').

The teachings of Abrams/Weissman have been discussed above.

Although, Abrams/Weissman teaches a system for analyzing the specimen container having the storage device such as the RFID device, a magnetic or optical stripe for storing data attached to the container, they fails to particularly teach or fairly suggest that the system comprises an imaging device, a processor, and a microscope.

However, Ellis teaches an automated image analysis system comprising a CCD camera (42) for capturing images of slide carrier having a biological specimen (60), a computer (22) having processors (e.g., a system processor (23) and a imaging processor (25)) for analyzing images of the specimen such as area of interests (e.g., color, size, and shape) and location of interests area (e.g., X-Y stage of interest area), and a viewing oculars (20) of the microscope subsystem for operator viewing (see Figs. 1-10; col. 1, lines 36—col. 2, line 3; col. 8, line 59-col. 12, 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Ellis to the teachings of Abrams/Weissman in order to provide an automated analyzing system by capturing the images of specimen and storing values of area of interests using the computer for also providing convenience retrieval of data regarding specimen by a pathologist or cytotechnologist. Moreover, such modification (e.g., an automated analyzing system

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comprising a viewing oculars) would provide an instant access to operator of the automated analyzing system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hollman (US 6,198,299) discloses an analytical probe station comprising a scanning electron microscope,

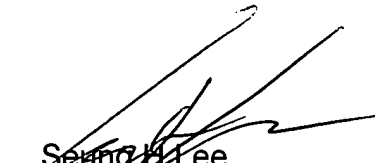
Bacus et al. (US 5,428,690) discloses an apparatus for automated assay of biological specimen located on the microscope slide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seung H. Lee whose telephone number is (571) 272-2401. The examiner can normally be reached on Monday-Friday, 7:30 AM- 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Seung H. Lee
Art Unit 2876
April 27, 2005